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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,998

06/17/2005

Jean-Marie Bernard

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1792

NOTIFICATION DATE

DELIVERY MODE

04/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/539,998	Applicant(s) BERNARD ET AL.	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The rejection of Claims 10-28 under 35 U.S.C. 112, first paragraph (“HDB”), is withdrawn because of the amendment filed 3/19/2009.

3. The rejection of Claim 19 under 35 U.S.C. 112, first paragraph, is withdrawn because of the amendment filed 3/19/2009.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19, 27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a) Claim 19: it is not clear if the "two-component polyurethane" in c) is the same or different as the "two-component polyurethane" of line 2.

b) Claim 27: does not make sense in that claim 10 is a composition claim.

c) Claim 30: "method" should not be underlined.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62 - 164049.

'049 teaches making a coating with HMDI, 2-(m)ethylimidazole as blocking group, and a polyol. There may be other imidazoles as blocking agent, as well as other species of blocking agent. It appears that a combination of some of the imidazole blocking agents would result in the limitation of claim 14. The coating is dried at 70 C after application. The drying time is not

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given, but it would have been obvious to optimize the drying time thru no more than routine experimentation. See Abstracts and pages 5, 7 and Examples of translation.

Response to Arguments

The applicant has argued that a polyol is not used. The examiner disagrees. Page 7 of the translation clearly teaches that a polyol may be used as the polymer that reacts with the blocked isocyanate. The applicant has also argued that Example 1 has three components and Example 2 has 5 components. It is the examiner's position that the other ingredients of the Examples are not required, and are merely exemplary of the process. In addition, the examiner takes note of the fact that only independent claims 10 and 17 use the closed language "consisting of", whereas the other independent claims use the open language of "comprising" or do not put limitations on the process.

8. Claims 10-11, 14-22, 25-30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flosbach et al (6013326).

'326 teaches a coating composition that comprises a hydroxy resin, and an isocyanate such as HDMI that may be blocked with 2-methylimidazole or other conventional blocking agents, and which is dried at 80-160 C for 20-40 minutes. The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C (see Abstract; 4:33-5:49; 7:45-8:18).

Response to Arguments

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The applicant has argued that '326 does not teach a two-component system. The examiner disagrees. The '326 process has both the polyol and the blocked isocyanate, and therefore is a two-component system.

9. The rejection of Claims 10-18 and 21-28 under 35 U.S.C. 103(a) as being unpatentable over JP 60 – 040121 is withdrawn because of the amendment filed 3/19/2009.

10. Claims 10-11, 14-22, 25-30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasar et al, Polymer International, 48, pp 614-620, 1999.

Nasar teaches reacting HMDI with 2-methylimidazole or benzimidazole to block the isocyanate group, followed by reaction with a polyol (see especially pages 615 and 620).

The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

March 29, 2009